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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	10/091,372
	Filing Date	March 4, 2002
	First Named Inventor	Eric M. Ferreira
	Art Unit	1755
	Examiner Name	Jam s W. Pasterczyk
Mail Stop	Attorney Docket Number	1950-0001

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**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> <b>No fee due</b> <input checked="" type="checkbox"/> <b>Fee Transmittal</b> <input type="checkbox"/> Fee(s) due <input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Check for \$* <input checked="" type="checkbox"/> <b>Charge any underpayment or credit any overpayment to Deposit Account No. 18-0580</b> <input checked="" type="checkbox"/> <b>Return postcard</b> <input checked="" type="checkbox"/> <b>Amendment/Reply</b> <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement & Form(s) PTO-1449 <input type="checkbox"/> Copy(ies) of cited reference(s) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts / Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s):	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks:</b> <b>The Commissioner is hereby authorized to charge any additional or underpayment of fee(s) to Deposit Account No. 18-0580.</b>		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual Name (print/type)	Shelley P. Eberle, Reg. No. 31,411 Reed & Eberle LLP	Telephone	(650) 330-0900
Signature	<i>Shelley P. Eberle</i>	Date	December 9, 2003

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Name (print/type)	Joe Clark		
Signature	<i>Joe Clark</i>	Date	December 9, 2003



# FEE TRANSMITTAL for FY 2004

Effective 10/01/03. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT \$0.00

## Complete if Known

Application Number 10/091,372  
Filing Date March 4, 2002  
First Named Inventor Eric M. Ferreira  
Examiner Name James W. Pasterczyk  
Group Art Unit 1755  
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## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☒ None

☐ Deposit Account:

Deposit Account No.

Deposit Account Name

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge any underpayment or credit any overpayments

☐ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) \$

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below	Fee Paid
Total Claims		- 42** =	0		
Independent Claims	4	- 4** =	0		
Multiple Dependent					

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claim in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) \$0.00

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) \$

## SUBMITTED BY

Name (Print/Type)	Shelley P. Eberle	Registration No. (Attorney/Agent)	31,411	Telephone	(650) 330-0900
Signature	Shelley P. Eberle	Date	December 9, 2003		



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**RECEIVED**  
**DEC 15 2003**  
**TC 1700**

In Re Application of:

Eric M. FERREIRA et al.

Confirmation No.: 7247

Serial No.: 10/091,372

Group Art Unit: 1755

Filing Date: March 4, 2002

Examiner: James W. PASTERCZYK

Title: METHODS AND COMPOSITIONS FOR ENANTIOSELECTIVE OXIDATION REACTIONS

**RESPONSE TO REQUIREMENT FOR RESTRICTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Requirement for Restriction mailed November 14, 2003.

**THE RESTRICTION REQUIREMENT**

The Examiner has required restriction between two groups of claims:

- (I) claims 1-24, drawn to a method of catalyzing an enantioselective oxidation reaction of an organic compound; and
- (II) claims 25-42, drawn to catalysts.

In response, applicants elect Group 1, claims 1-24, without traverse. Applicants expressly reserve their right under 35 USC § 121 to file a divisional application directed to the non-elected subject matter during the pendency of this application.

**THE REQUIREMENT FOR AN ELECTION OF SPECIES**

The Examiner has also indicated that the claims are generic to a plurality of patentably distinct species comprising various substrates and products made using the claimed process. In making the present restriction requirement, the Examiner has simply stated that there are a "plurality" of patentably distinct species comprising various substrates and products made using the claimed process. This treatment of the claims is inconsistent with the guidance given Examiners in the Manual of Patent Examining Procedure, where it is stated that the "best way to

most clearly and precisely indicate...how an application should be restricted" is to identify each separate subject and then group each claim with the subject. M.P.E.P. Section 814, part B. That section of the M.P.E.P. goes on to state that "[t]he separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group...." While this discussion pertains to restriction practice, at a minimum, the Examiner should identify what is considered to be a "species."

In the present case, the restricted subject matter has not been presented with an identification of separate species, as is normally done, and therefore the Examiner has not provided any guidance as to what species are to be elected.

Claim 1 is directed to a method of catalyzing an enantioselective oxidation reaction of an organic compound comprising contacting the organic compound with an oxidizing agent, and a catalyst comprising a metal composition and a chiral ligand. Absent any guidance from the Examiner, it would appear that a possible species could be the different enantioselective oxidation reactions, organic compounds, oxidizing agents, and catalysts (metal composition and chiral ligand) encompassed by Claim 1. Therefore, the following election is an attempt to provide a complete response to the request for election under 35 U.S.C. § 121.

For the enantioselective oxidation reaction, Applicants elect the kinetic resolution of a racemic mixture. Claims 1-17 read on this reaction species. Claims 18-24 do not read on this species.

For the organic compound, Applicants elect alcohols. Claims 1-24 all read on this compound species.

For the oxidizing agent, Applicants elect molecular oxygen. Claims 1-24 all read on this agent species.

For the metal composition, Applicants elect palladium (II) complex, with a sub-species election of Pd(norbornadiene)Cl<sub>2</sub>, if needed. Claims 1-24 all read on this composition species.

For the chiral ligand, Applicants elect (-)-sparteine. Claims 1-24 all read on this ligand species.

It is to be understood that the aforementioned election of species is for the purpose of the Examiner's initial search and examination, and that upon allowance of a generic claim all remaining species encompassed by that claim should properly be examined.

If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, they are welcome to contact the undersigned attorney at (650) 330-0900.

Respectfully submitted,

By: Shelley P. Eberle  
Shelley P. Eberle  
Registration No. 31,411

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